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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,927	11/01/2001	Joseph Morris	210166US67	3502

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EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/682,927

Applicant(s)

MORRIS, JOSEPH

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/4/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment filed 4/4/2005. Accordingly, claims 13-16 are canceled, and claims 1-12 are pending for examination.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 4/4/2005 has been considered.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 1 and 7, the subject matter of a second number accessible via the first and second telephone interfaces such that the call processor directs the outgoing call to the second telephone line interfaces using the second number when the first number is determined to match the stored telephone number is not described in the specification. Note the specification merely describes a call processor providing local called number translation to translate an entry 800 number, i.e., a first number, to a non-800 number, i.e., a second number, when the first number is determined to match with one of a plurality of stored numbers stored in a database, so that the call processor uses the second number to direct an outgoing call to a second telephone

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line interface, and the call processing uses the second number sent back from a remote call handler to direct the outgoing call to POTS interface when a connection request cannot handle by the second telephone line interface ([0016] through [0017]). Thus, the specification fails to describe the second number accessible via the first and second telephone line interfaces.

Claims 2-6 and 8-12 are also rejected because of depending on claims 1 and 7, respectively, containing the same deficiency.

### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the processor further comprises a telephone number converter for converting a first number, accessible by the first telephone line interface but not accessible via the second telephone line interface, to a second number, **accessible via the first and second telephone line interfaces**, when the first number is determined to match the stored telephone number, such that **the call processor directs the outgoing call to the second telephone line interface using the second number when the first number is determined to match the stored telephone number** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (US PAT. 6,141,341 hereinafter Jones) in view of Hakim et al. (US PAT. 6,614,780 hereinafter Hakim) and Sosnowski (US PAT. 5,754,640).

Regarding claim 1, Jones discloses an Internet Protocol telephone system for routing a call between a first telephone line interface (18, figure 2) and a second telephone line interface (14, figure 2) depending on an entered number (col. 2 lines 17-31), the system comprising a telephone digit detector (52, figure 5) for detecting and buffering a series of digits received from

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a telephone line connector (col. 3 lines 27-29 and col. 9 lines 22-28), a call processor (32, figure 4) for determining if the buffered series of digits matches a stored telephone number (col. 3 lines 29-30) and a telephone line switch (10) for directing an outgoing call to the first telephone interface, i.e., a POTS mode, and to the second telephone line interface, i.e., a VoIP mode, based on an output of the caller processor (col. 3 lines 30-34 and col. 9 lines 40-61). Jones differs from the claimed invention in not specifically teaching the call processor comprising a telephone number converter for converting the buffered series of digits from a first number, accessible by the first telephone line interface but not accessible by via the second telephone line interface, to a second number accessible via second telephone line interface when the first number is determined to match the stored number such that the call processor directs the outgoing call to the second telephone line interface using the second number. However, Hakim teaches a system for routing a dialed telephone number comprising a microprocessor (704, figure 7), wherein the microprocessor comprising means for converting from a first number, i.e., toll free number which is accessible by a PSTN interface, i.e., a first telephone line interface, to a second number accessible by local service provider or Internet service provider, i.e., a second telephone line interface, so that the microprocessor directs the outgoing call to the second telephone line interface using the second number (col. 6 line 30 through col. 8 line 59), thereby enabling minimal charge to the call. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Jones in having the call processor comprising a telephone number converter for converting the buffered series of digits from a first number, accessible by the first telephone line interface but not accessible by via the second telephone line interface, to a second number accessible via second telephone line interface when

the first number is determined to match the stored number such that the call processor directs the outgoing call to the second telephone line interface using the second number, as per teaching of Hakim, in order to enable minimal charge to the call. Furthermore, neither Jones nor Hakim specifically teaches the second number accessible by the first and second telephone line interfaces. However, Sosnowski teaches to selectively routing a destination telephone number, i.e., a first number, accessible by a standard switching network, or a selective telephone network depending upon the destination number being matched with a stored telephone number (col. 6 lines 10-37), so that the destination number, which is accessible via first and second interface, is being routed to an appropriate interface depending upon the telephone network services the particular area associated with a dialed telephone number. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Jones and Hakim in having the second number accessible by the first and second telephone line interfaces, as per teaching of Sosnowski, in order to qualify telephone numbers for a telephone network according to whether the telephone network services the particular area associated with the dialed telephone number.

Regarding claims 2-5, Hakim teaches the stored telephone number comprising a toll-free number or an information number, wherein the toll-free number or the information number includes an 800 number (col. 1 lines 38-49).

Regarding claim 6, Jones discloses the second telephone line interface (14, figure 2) comprising a Voice-over-IP interface (col. 2 lines 17-25 and col. 9 lines 40-46).

Regarding claim 7, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 8-11, the limitations of the claims are rejected as the same reasons set forth in claims 2-5.

Regarding claim 12, the limitations of the claim are rejected as the same reasons set forth in claim 6.

### ***Response to Arguments***

7. Applicant's arguments filed 4/4/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the specification at paragraph [0017] teaches the database may including a translation entry for the number 800-555-1212 to a local number 973-555-1212, wherein the location number can be accessed by both the first interface (POTS) and the second interface (140), it is noted that paragraph [0017] in the specification merely defines the data base may include an that indicates calls to France should be place d to the POTS interface 130 at certain hours, and the translation entry for the number is shown in paragraph [0019] in the specification. However, neither paragraphs [0017] nor [0019] discloses the local number can be accessed by both the first interface and the second interface. According paragraph [0019] in the specification, the paragraph merely teaches the number can be translated to a non-800 number that can be connected to the via the second interface 140, thereby the database can override the normal use of the POTS interface and increase the use of the second interface. Thus, the specification fails to clearly teach the translated number can be accessed by both the first and second interface. Furthermore, figure 2 only discloses to receive dialed digit and the processor operable to switch to POTS interface if totally match occurs, and further determine whether any



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remaining numbers in database of number that might still be matched if the call processor determines that a total match is not yet occurred, and direct the call to the secondary telephone line interface if no number exist in the database that could still be a possible match (see paragraph [0012] through [0015]). Thus, figure 2 fails to illustrate the local number can be accessed by both the first POTS interface and the second interface.

In response to applicant's argument to withdraw the drawing objection due to figure 2 illustrating the claimed features, it is noted that figure 2 only discloses to receive dialed digit and the processor operable to switch to POTS interface if totally match occurs, and further determine whether any remaining numbers in database of number that might still be matched if the call processor determines that a total match is not yet occurred, and direct the call to the secondary telephone line interface if no number exist in the database that could still be a possible match (see paragraph [0012] through [0015]). Thus, figure 2 fails to illustrate the claimed feature, i.e., the local number can be accessed by both the first POTS interface and the second interface.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument *Sosnowski* fails to teach converting a first number to a second number where a telephone number is accessible by both the first and second interface, it is noted that both *Jones* and *Hakim* teaches to convert a first number to a second number (see rejection above). The purpose of *Sosnowski* is for teaching a telephone number is accessible by both the first and second interface. According to *Sosnowski*, the telephone number being

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selectively routed by a standard switching network or a selective telephone network depending upon the destination number being matched with a stored telephone number (col. 6 lines 10-37). Thus, the telephone number is clearly being accessible by different interface, i.e., standard switching network interface and selective telephone network interface depending upon the number being matched with the stored number in a database. Thus, the combination of Jones, Hakim and Sosnowski teaches the claimed limitations.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

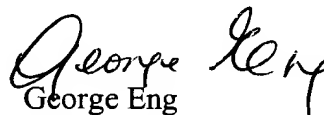
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
George Eng  
Primary Examiner  
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